

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANJAR AZAR,
and BABAK AZAR

Appeal No. 95-3681
Application 07/956,705¹

ON BRIEF

Before KRASS, FLEMING, and TORCZON, **Administrative Patent Judges**.
Fleming, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection
of claims 1 through 39, all of the claims pending in the
application.

The invention relates to a method and apparatus for
determining the most economical telephone carrier when a

¹ Application for patent filed October 5, 1992.

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telephone number is dialed and, thereafter automatically dialing the telephone number via that most economical carrier.

The independent claim 17 is reproduced as follows:

17. A method of automatically selecting a telecommunications carrier or any entity providing telecommunications service for placement of a telephone call with a carrier providing the least costly rates, said method comprising the steps of:

a) capturing a telephone number dialed from a telephone or a cellular phone, or entered into a keyboard of a fax or computer/modem, or dialed via software;

b) determining rates for each carrier providing service between a caller location and a destination of the captured telephone number;

c) comparing carrier rates;

d) then selecting the most economical carrier for handling placement of the telephone call;

e) automatically appending an access code of the selected carrier to the telephone number; and

f) generating a telephone number with said appended access code for routing to a telephone line or system via in-band or out-of-band signaling methods.

The references relied on by the Examiner is as follows:

Mincone et al. (Mincone)	4,585,904	Apr. 29, 1986
Treat	4,751,728	June 14, 1988
Riskin	4,757,267	July 12, 1988

The specification is objected to under 35 U.S.C. § 112, first paragraph, for failing to provide an enabling disclosure. Claims 5, 9 and 36 through 38 are rejected under 35 U.S.C. § 112,

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first paragraph, for reasons set forth in the objection to the specification. Claims 1 through 3, 5 through 20, 22 through 33 and 35 through 39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mincone and Treat. Claims 4, 21 and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mincone, Treat and Riskin.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the brief and the answer for the details thereof.

OPINION

After a careful review of the evidence before us, we agree with the Examiner that claims 1 through 15 and 17 through 39 are properly rejected under 35 U.S.C. § 103. However, we do not agree that claim 16 is properly rejected under 35 U.S.C. § 103 nor do we agree that claims 5, 9 and 35 through 39 are properly rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth *infra*.

In order to comply with the enablement provision of 35 U.S.C. § 112, first paragraph, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. *In re Scarbrough*, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974); *In re Brandstadter*,

484 F.2d 1395, 179 USPQ 286 (CCPA 1973); and *In re Gay*, 309 F.2d 769, 772, 135 USPQ 311, 315 (CCPA 1962). If the Examiner had a reasonable basis for questioning the sufficiency of the disclosure, the burden shifted to the Appellant to come forward with evidence to rebut this challenge. *In re Doyle*, 482 F.2d 1385, 1392, 179 USPQ 227, 232-33 (CCPA 1973), **cert. denied**, 416 U.S. 935 (1974); *In re Brown*, 477 F.2d 946, 950, 177 USPQ 691, 694 (CCPA 1973); and *In re Ghiron*, 442 F.2d 985, 992, 169 USPQ 723, 728 (CCPA 1971). However, the burden was initially upon the Examiner to establish a reasonable basis for questioning the adequacy of the disclosure. *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976); and *In re Armbruster*, 512 F.2d 676, 678, 185 USPQ 152, 154 (CCPA 1975).

We fail to find that the Examiner had a reasonable basis for questioning the sufficiency of the disclosure. Appellants' claim 5 recites the first memory is operatively connected to an updating means for updating, for storing and for deleting vertical and horizontal coordinates of a geographical location. We take notice that it is well within the skill of the art for an artisan to provide a computer memory which is able to update, store and delete information in memory at the time of

Appellants' filing. The Examiner's argument directed to the task of gathering and dissemination is not persuasive because Appellants' claim 5 is not limited to any structure for gathering or disseminating.² The Appellants' claim is directed to a memory system for updating, storing and deleting information in a memory. In view of the scope of Appellants' claim 5, we find that one of ordinary skill in art would have been able to provide a updating means for updating, storing and deleting information in a memory at the time of Appellants' filing.

Similarly, we note that Appellants' claim 9 recites "wherein said digit capture buffer board monitors when the telephone handset is functionally off the hook or disconnected from the dialing means."³ The Examiner argues that Appellants' disclosure is inadequate because the off-hook detection is shown to be a separate element from the dial capture buffer board. However, we note that Appellants are free to set claim elements that include many of Appellants' disclosed elements.

Finally, the Examiner argues that claims 36 through 38 recited hardware that is not shown in the drawing or the dis-

² The specification does not provide significantly more structure than the claim. (Page 11)

³ As a side issue, we note that "the telephone handset" does not appear to have a proper antecedent basis.

closure. However, Appellants recite well-known hardware in claims 36 through 38. Claim 36 recites that the processing means resides on an integrated circuit chip. Claim 37 recites that the processing means resides on a plug-in printed circuit board. Claim 38 recites that the processing means resides in telephone set containing displays and LEDs in addition to the standard user interfaces. We find that one of ordinary skill in the art at the time of Appellants' filing would have been able to make and use these hardware elements without more than routine experimentation. Therefore, we fail to find that the Examiner has shown any support for a reasonable basis for questioning the sufficiency of the disclosure.

Claims 1 through 3, 5 through 20, 22 through 33 and 35 through 39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mincone and Treat. Claims 4, 21 and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mincone, Treat and Riskin.

At the outset, we note that Appellants state on page 6 of the brief that the claims should not be grouped together. On pages 7 through 14 of the brief, we note that Appellants argue claims 1 through 3, 5 through 20, 22 through 33 and 35 through 39 as a group with the exception of claim 16 which is argued separately. We note that Appellants do point out what claim 5

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covers but Appellants do not argue as why the claim is separately patentable. In addition, on pages 14 and 15, Appellants argue claims 4, 21 and 34 as a group. 37 CFR § 1.192(c)(5) amended October 22, 1993 states:

For each ground of rejection which appellant contests and which applies to more than one claim, it will be presumed that the rejected claims stand or fall together unless a statement is included that the claims of the group do not stand or fall together, and in the appropriate part or parts of the argument under subparagraph (c)(6) of this section appellant presents reasons to why appellant considers the rejected claims to be separately patentable.

As per 37 CFR § 1.192(c)(5), which was controlling at the time of Appellants' filing the brief, we will, thereby, consider Appellant's claims 1 through 3, 5 through 15, 17 through 20, 22 through 33 and 35 through 39 to stand or fall together, with claim 17 being considered the representative claim. Furthermore, we will consider claim 16 separately. Finally, we will consider claims 4, 21 and 34 to stand or fall together.

On pages 7 and 10 of the brief, Appellants argue that Treat does not provide an enabling teaching for automatic selection of a carrier for placement of a telephone call.

However, other than an Appellants' opinion, Appellants have not provided any evidence in the record that Treat is not enabling. A reference is presumed to be enabled for the purpose of an obviousness rejection. The reference may also be enabled by other references. The burden rests with the applicants to establish that the prior art is not enabling. ***In re Payne***, 606 F.2d 303, 314-15, 203 USPQ 245, 255-56 (CPA 1979); ***In re Epstein***, 32 F.3d 1559, 1568-69, 31 USPQ2d 1817, 1823-24 (Fed. Cir. 1994). Furthermore, the test of obviousness is not whether features of a secondary reference may be bodily incorporated into the primary reference's structure, nor whether the claimed invention is expressly suggested in any one or all of the references; rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. ***See In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

On pages 7 through 10, Appellants further argue that Treat does not teach a method for automatic selection of a carrier for placement of a telephone call. Appellants point to a portion of Treat that teaches displaying a list of carriers for user selection. However, appellants overlook another embodiment of Treat which does teach a method for automatic selection of a carrier for placement for a telephone call. In particular, Treat

teaches in column 5, lines 1 through 30, another embodiment of Treat's device which is able to predict the cheapest carrier and to automatically dial the carrier to place the cheapest call. Furthermore, in column 6, lines 49 and 50, Treat teaches a telephone call monitoring, metering and selection means having the capability of selecting the cheapest carrier. In column 6, line 67, through column 7, line 5, Treat teaches that the telephone call monitoring, metering and selection means includes means which automatically dial that carrier to place the cheapest call. Therefore, we find that Treat does teach the method of automatically generating a telephone number with the appended access code for routing to a telephone line as claimed in Appellants' claim 17.

On pages 11 and 12, Appellants argue that the Examiner has not provided a reason for combining Treat with Mincone. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). In addition, the Federal Circuit states that "[t]he mere fact that the prior art may be

modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

"Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 117 S.Ct. 80 (1996), ***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984). In addition, the Federal Circuit reasons in ***Para-Ordnance Mfg.***, 73 F.3d at 1087-88, 37 USPQ2d at 1239-40, that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem, and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants.

Upon a closer reading of Treat, we find that Treat specifically mentions Mincone as well as other prior art devices

in column 1, lines 10-29. Furthermore, Treat teaches in column 1, line 30 through column 2, lines 56, that it is the objective of the Treat invention to improve upon these prior art devices to provide a telephone system apparatus that monitors, meters and selects the low-cost carrier and then automatically dials the long distance call. Therefore, in view of these specific reasons of modifying Mincone as taught by Treat, we find that it would have been obvious to those skilled in the art having the teachings of Treat before them to provide a method of automatically selecting a telecommunication carrier as recited in Appellants' claim 17.

On page 13 of the brief, Appellants argue that their invention isolates the telephone from the user's telephone company, while maintaining a dial tone. However, we note that this limitation is not recited in Appellants' claim 17. Therefore, the Examiner is not required to provide such a showing.

On page 13 of the brief, Appellants argue with respect to claim 16 that their invention detects incoming calls, so that the dialing procedure can be interrupted. We note that claim 16 recites a means for detecting an incoming call, wherein a dialed telephone number can be interrupted during operator input dialing of the number to answer an incoming call. On page 19 of the

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answer, the Examiner points out that fax machines as well as cellular phones operate such that the number must be stored and then outputted to the central office when the user presses the "send" key.

We agree that fax machines and cellular telephones that are in use at the time of this opinion operate as described by the Examiner. However, the Examiner has not provided any evidence that such systems were known prior to the filing of Appellants' application. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or unquestionable demonstration. Our reviewing court requires this evidence in order to establish a *prima facie* case. *In re Knapp-Monarch Co.*, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); *In re Cofer*, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Therefore, we will not sustain the Examiner rejection of claim 16.

Claims 4, 21 and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mincone, Treat and Riskin. Appellants argue on pages 14 and 15 of the brief that the proposed Examiner's combination is untenable since the proposed combination is a system that was not then commercially available.

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We note that Appellants have not provided any evidence to support this statement. Furthermore, even if there is evidence to support the statement, we find this argument without merit because the lack of commercially availability does not rebut the Examiner's *prima facie* case of obviousness establishing that it would have been obvious to those skilled in the art to obtain Appellants' claimed invention in view of the teachings of Mincone, Treat and Riskin. We note that Appellants have not provided arguments that specify the error in the Examiner's rejection and that explain why the references, taken as a whole, do not suggest the claimed subject matter. Therefore, we will sustain the Examiner's rejection of claims 4, 21 and 34 under 35 U.S.C. § 103 as being unpatentable over Mincone, Treat and Riskin.

In view of the foregoing, the decision of the Examiner rejecting claims 1 through 15 and 17 through 39 under 35 U.S.C. § 103 is affirmed; however, the decision of the Examiner rejecting claim 16 under 35 U.S.C. § 103 is reversed. In addition, the decision of the Examiner rejecting claims 5, 9 and 36 through 38 under 35 U.S.C. § 112, first paragraph, is reversed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
MICHAEL R. FLEMING)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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